

### **REMARKS**

In response to the above-identified Office Action, Applicant amends the application and seeks reconsideration thereof. In this response, Claims 7, 10 and 12 have been amended, no claims have been added and no claims have been cancelled. Accordingly, Claims 1-13 are pending.

The instant invention is directed to a system for joining sections of composite reinforced line pipe comprising a first and second pipe segment each having a core and a composite reinforcement circumferentially surrounding the core, each pipe segment further having a first end with a cutback region in which the core is exposed, the first and second pipe segments joined at their respective first ends, and a joint tape overlying the cutback region and adhering to the first and second pipe segments.

#### **I. Information Disclosure Statement Objection Under 37 CFR 1.98(a)(2)**

In the outstanding Office Action, the Examiner refuses to consider the information disclosure statement filed on 4/7/2004 for failing to comply with 37 CFR 1.98(a)(2) which requires a legible copy of each U.S. and foreign patent and all publications or portions thereof causing them to be listed. Applicant respectfully submits, copies of the foreign patents and publications listed on the information disclosure statement filed on 4/7/2004 were submitted in the parent case. Please see Image File Wrapper for U.S. Application Ser. No. 10/354,491 shown on the Patent Application Information Retrieval System. Accordingly, the information disclosure statement filed on 4/7/2004 was proper and should be considered. In view of the

foregoing, Applicant respectfully requests withdrawal of the Examiner's objection under 37 CFR 1.98(a)(2).

## **II. Claim Objections**

In the outstanding Office Action, the Examiner objects to Claims 7, 10 and 12. Specifically, the Examiner determines there is insufficient antecedent basis for the limitation of "the reinforcement layer" in Claim 7, and the term "jointed" as recited in Claims 10 and 12 should be corrected to recite "joined." Applicant respectfully submits the attached Amendments to the Claims in which Claim 7 has been amended to recite "the reinforcement tape." Claim 6 provides sufficient antecedent basis for this limitation. Claims 10 and 12 have been amended to recite "joined" instead of "jointed" as suggested by the Examiner. The attached Amendments to the Claims do not add new matter and are supported by the Specification. For the foregoing reasons, Applicant respectfully requests withdrawal of the objections to Claims 7, 10 and 12 and entry of the attached Amendments to the Claims.

## **III. Claims Rejected Under 35 U.S.C. §102**

In the outstanding Office Action the Examiner rejects Claims 1-4, and 9-13 under 35 U.S.C. §102 as being anticipated by van der Linden et. al., U.S. Patent No. 4,732,412 ("Linden"). The Examiner further rejects Claims 1, 4-7 and 10-11 under 35 U.S.C. §102 as being anticipated by Galloway., U.S. Patent No. 3,053,724 ("Galloway"). Applicant respectfully traverse the rejection for at least the reasons set forth below.

Anticipation may only be established if "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Linden, U.S. Patent No. 4,732,412

In regard to Claims 1, 10 and 12, Applicant respectfully submits that Linden fails to teach or suggest at least the element of a first and second segment each having a core and composite reinforcement surrounding the core and a composite reinforcement means circumferentially surrounding the core to provide hoop strength.

In the outstanding Office Action, the Examiner alleges Linden teaches an asbestos cement surrounding a first and second pipe segment core. See Linden, Col. 8, line 9. The Examiner alleges that an asbestos cement teaches Applicant’s claimed composite reinforcement surrounding the core which provides hoop strength to the underlying pipe. Applicant respectfully disagrees with the Examiner’s characterization of Linden. Linden teaches that the asbestos cement surrounds an insulation layer around a metal pipe. Such as may have been historically used for hot water pipes in construction. Linden does not suggest, and the Examiner has not shown, that the asbestos cement or insulation layer provide any increase in hoop strength for the underlying pipe. Thus, Linden fails to teach or suggest at least this element. Since Linden fails to teach or suggest all the elements of Claims 1, 10 and 12, anticipation may not be found.

Moreover, in regard to Claims 10 and 12, Applicant respectfully submits, these claims further recite the element of a joint tape overlaying the joined ends of the pipe segment to provide hoop strength and reinforcement. Specifically, Claim 10

recites a joint tape means circumferentially overlaying the first ends adjacent the cutback region to provide hoop strength and Claim 12 recites a joint tape circumferentially overlaying the first and second pipe segments at the cutback region to provide hoop reinforcement. The Examiner alleges, element 1 of Linden teaches this element. Applicant respectfully disagrees with the Examiner's characterization of element 1. Linden describes element 1 as the polymeric material of a sleeve. Specifically, Linden teaches the sleeve comprises "a recoverable polymeric material 1 with a sealant coating 3 and two hot-melt adhesive coatings 2." See Linden, Col. 8, lines 21-23. The sleeve is used to protect the exposed pipe from the heat required for welding, not to strengthen or otherwise reinforce the underlying pipe. See Linden, Col. 7, lines 41-46. Thus, there is no teaching or suggestion in Linden that the polymeric material 1 of the sleeve provides hoop strength or reinforces the pipe segments. Thus, Linden further fails to teach or suggest at least this element as recited in Claims 10 and 12.

In regard to dependent claims 2-4 and 9, Applicant respectfully submits Claims 2-4 and 9 depend from Claim 1 and incorporate the limitations thereof. In regard to dependent Claim 11, Claim 11 depends from Claim 10 and incorporates the limitations thereof. In regard dependent Claim 13, Claim 13 depends from Claim 12 and incorporates the limitations thereof. Thus, for at least the reasons discussed with respect to Claim 1, 10 and 12 Linden fails to teach or suggest each element of Claims 2-4, 9, 11 and 13. Since Linden fails to teach all the element of Claims 2-4, 9, 11 and 13, anticipation may not be found.

Moreover, with respect to Claim 4, Applicant respectfully submits Linden fails to disclose a resin saturated reinforcement tape as further recited in Claim 4. The Examiner alleges element 1 of Linden teaches a resin saturated reinforcement tape. As previously discussed, Linden describes element 1 as the polymeric material of a sleeve. The Examiner erroneously contends that the polymeric sleeve teaches a resin saturated reinforcement tape because if a tape is made from a resin material, it must be saturated with resin material. Applicant respectfully disagrees with the Examiner's reasoning. The term "saturate," necessarily implies the presence of two materials one of which is impregnated to its capacity with the other such that no more of the other material may be retained or absorbed by the impregnated material. Accordingly, a tape, which is in and of itself a resin, is not *saturated* with a resin.

In view of the foregoing, it is respectfully requested that the rejections of Claims 1-4, 9 and 12-13 under 35 U.S.C. §102 as being anticipated by Linden be withdrawn.

Galloway, U.S. Patent No. 3,053,724

In regard to Claims 1 and 10 Applicant respectfully submits that Galloway fails to teach or suggest at least the element of a first and second pipe segment each having a core and a composite reinforcement circumferentially surrounding the core. Galloway teaches a method of splicing sections of a heavy-duty discharge hose. Galloway teaches that the hose is comprised of an inner rubber or comparable tube with a plurality of plies of rubber impregnated fabric wound spirally around the inner tube. See Galloway, Col. 2, lines 27-35. The Examiner alleges elements 2 and

2' teach first and second pipe segments, respectively, and 4, 4' teach a composite reinforcing circumferentially surrounding the core of each segment.

Applicant respectfully disagrees with the Examiner's characterization of Galloway and submits the Galloway invention is directed toward an entirely different field of endeavor than Applicant's invention. As set forth above, Galloway teaches a method for splicing a "flexible hose." Galloway further teaches an advantage of the invention over known methods is its light weight due to the elimination of metallic coupling members typically used to join the hose end sections together. See Galloway, Col. 1, lines 35-60. In contrast, Applicant's invention claims an apparatus for joining pipe segments together. A "pipe" is not the same element as the "flexible hose" taught by Galloway. Applicant has been unable to discern, and the Examiner has not shown, any portion of Galloway teaching a first and second pipe segment having a core and composite reinforcement. Since Galloway fails to teach or suggest each element of Claims 1 and 10, anticipation may not be found.

Moreover, with respect to Claim 6, Claim 6 further recites the element of a resin reinforcement tape comprised of a warp-dominated fiber material. The Examiner alleges this element is taught by Col. 3, lines 45-52 of Galloway. Applicant has reviewed the portion of Galloway relied upon by the Examiner and has been unable to discern any teaching of a resin reinforcement tape made of a "warp-dominated" fiber material as recited in Claim 6. Instead, Col. 3, lines 45-53 of Galloway merely discusses that the cord fabric 15, which is similar to 14 (rubber impregnated tire cord tape), has warp yarns extending at a like angle to the mandrel

axis. There is no teaching or suggestion in Galloway that the warp yarns dominate the fiber material. Accordingly, for at least the reasons set forth above, Galloway does not teach or suggest all the elements of Claim 6. Since Galloway fails to teach or suggest each element of Claims 6, anticipation may not be found.

In regard to Claims 4, 5, 7 and 11, Applicant respectfully submits Claims 4, 5 and 7 depend from Claim 1 and Claim 11 depends from Claim 10. Thus, since Claims 4, 5, 7 and 11 incorporate the limitations of Claims 1 and 10, respectively, Galloway does not teach each element of the claims for at least the reasons discussed above with respect to Claims 1 and 10. Since each element of Claims 4, 5, 7 and 10 is not taught or suggested by Galloway, anticipation may not be found.

In view of the foregoing, it is respectfully requested that the rejections of Claims 1, 4-7 and 10-11 under 35 U.S.C. §102 as being anticipated by Galloway be withdrawn.

#### **IV. Claims Rejected Under 35 U.S.C. §103**

In the outstanding Office Action the Examiner rejects Claim 8 under 35 U.S.C. §103(a) as being obvious over Galloway, in view of Ewing et. al., U.S. Patent No. 4,023,834 ("Ewing"). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests every limitation of the claim such that the invention as a whole would have been obvious at the time the invention was made to one skilled in the art.

In regard to claim 8, Claim 8 depends from Claim 1 and thus incorporates the limitations thereof. Claim 8 further recites the elements of wherein the joint

tape comprises an isopolyester resin, and a plurality of glass fibers seated in the polyester resin. The Examiner recognizes Galloway fails to teach this element of Claim 8 and instead relies upon Ewing. The Examiner alleges Ewing teaches that glass and nylon are equivalents well known in the art used for providing strength therefore it would have been obvious to one of ordinary skill in the art to substitute the nylon fibers taught in Galloway with glass fibers.

Applicant respectfully submits, at least for the reasons discussed above with respect to Claim 1, Galloway fails to teach or suggest at least the element of a first and second pipe segment having a core and a composite reinforcement circumferentially surrounding the core as recited in Claim 8. The Examiner has not pointed to, and Applicant is unable to discern, any portion of Ewing teaching this element. Thus, for the reasons set forth above, the relied upon references fail to teach or suggest at least this element of Claim 8. Since every element is not taught or suggested by Galloway in view of Ewing, a *prima facie* case of obviousness has not been established.

Moreover, the Examiner has improperly combined the references of Galloway and Ewing in attempting to render Claim 8 obvious. The Examiner alleges it would have been obvious to a person having ordinary skill in the art at the time the invention was made to substitute the nylon fibers of Galloway with glass fibers because they are equivalents. Applicant respectfully submits, knowledge that materials are equivalent would not motivate one of ordinary skill in the art to substitute nylon fibers for glass fibers because there would be no recognized advantage to making the substitution. The motivation and desire to modify what is



already known arises when the modification will result in some sort of desired advantage or increased performance. By the Examiner's own admission, there would be no benefit to reconstructing Galloway in view of the teachings of Ewing. Moreover although substituting nylon fibers for glass may have been "obvious to try", as the Examiner is not doubt aware, this is not the appropriate standard in finding a combination obvious. Thus, it is only upon viewing Applicant's disclosure that the desirability of using an isopolyester resin and glass fibers seated in the polyester resin is recognized. Such hindsight reconstruction is also not an appropriate basis for finding obviousness. Accordingly, even if it were possible to combine Galloway with Ewing to arrive at Applicant's invention, there is no motivation to do so.

For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 8 under 35 U.S.C. §103(a) over Galloway in view of Ewing.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

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Dated: 3/31/05

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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 31, 2005.

Lillian E. Rodriguez 3-31-05  
Lillian Rodriguez March 31, 2005